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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,030	12/20/2001	Ananthanarayan Venkateswaran	AA411M	5106

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 12/24/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b> <i>File Copy</i>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/019,030	VENKATESWARAN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	JYOTHSNA A VENKAT	1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 May 2002.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-10 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u>	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

Receipt is acknowledged of IDS, preliminary amendment A and change of address filed on 3/28/01 and 5/7/02.

Claims 1-10 are pending in the application and the status of the application is as follows:

### *Information Disclosure Statement*

The references cited in the Search Report have been considered, because they were provided on a separate list in compliance with 37 CFR 1.98(a)(1).

### *Priority*

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

*Applicants are also notified that the instant application is claiming benefit under 35 U.S.C. 119 with respect to PCT/US99/15112 filed on 7/2/99. It appears that the 371 application is either a continuation or CIP of PCT/US99/15112 filed on 7/2/99. Clarification is requested.*

### *Specification*

1. The disclosure is objected to because of the following informalities:
2. *The specification at page 14 defines formula II without any definition for the variables a and b. The specification also defines variables x and y as integers without defining the integers. The same is true for formula IV at page 15. There is no definition for a and b and the integers m and n are not defined in the specification.*

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following reasons apply:

1. The expression "*from about 0.1% to about 20% of a cationic emulsion comprising by weight of the cationic emulsion from about 1% to about 20% of a cationic surfactant and emulsifiable amount of silicone compound*" is ambiguous and unclear as to applicant's intent. Note that the cationic silicone emulsion has two principal components namely cationic surfactant and silicone compound. The concentration of the silicone emulsion is same as the concentration of the cationic surfactant and yet the composition also has the silicone compound. The claim does not comply with the 112, 2<sup>nd</sup> paragraph.
2. Claim 5 is indefinite and lacks antecedent basis, as the *conditioning agent* is *cationic*. The formula recited is not cationic. Additionally the claim recites "*a acid -----thereof*". There is no connection between the formula and the acid. Furthermore the claim recites the expression "*general*" which is indefinite as the claim recites specific formula. **Deletion** of "*general*" is suggested.
3. The recitation of "*having from about 1 to about 30 carbons*" for the definition of alkyl, aryl and alkyl aryl is indefinite, as the carbon atoms have fixed chain length. **Deletion** of "*about*" is suggested. Additionally the simplest unsaturated alkyl has 2 carbon atoms and aryl has starting

from 6 carbon atoms. Furthermore the expression “ *having* “ has the same meaning as “ comprising”. The following language is suggested” **alkyl with 1 to 30 carbon atoms**”.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/19655('655).

**The rejection is based upon the teaching at page 4 of the specification that the silicone compound is comprised from 0.1 to 70%.**

The instant application is claiming a hair conditioning composition comprising by weight:

- a. *from about 0.1% to about 20% of a cationic emulsion comprising by weight of the cationic emulsion from about 1% to about 20% of a cationic surfactant and emulsifiable amount of silicone compound*
- b. *0.1% to about 15% of a high melting point fatty compound*
- c. *from about 0.1% to about 10% of a cationic conditioning agent*
- d. *an aqueous carrier*

The WO document '655 discloses silicone emulsion at page 4, lines 14-35, page 5, lines 6-8 for the range of the silicone polymer which overlaps with the range disclosed in the specification, see pages 6-9 for the silicone compound, see pages 10-14 for the cationic

surfactant, see pages 18-20 for the fatty compound, see page 14, lines 10 et seq and 15-17 for the conditioning agents. The ranges overlap. The expression comprising is inclusive of all the unrecited ingredients in major amounts.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of WO '655 and U. S. Patent 6,468,515 ('515).

The instant application is claiming a hair conditioning composition comprising by weight:

a. *From about 0.1% to about 20% of a cationic emulsion comprising by weight of the cationic emulsion from about 1% to about 20% of a cationic surfactant and emulsifiable amount of silicone compound*

- b. 0.1% to about 15% of a high melting point fatty compound*
- c. From about 0.1% to about 10% of a cationic conditioning agent*
- d. An aqueous carrier*
- e. Low melting oil, which can be either fatty alcohol of claim 7, or either pentaerythritol ester oils or citrate ester oils of claim 8*
- f. Polyethylene glycol(claim 9)*

The WO document teaches all the ingredients up to d in hair compositions. The document does not teach ingredients e-f in the hair compositions. However the patent '515 teaches hair conditioning compositions comprising high molecular ester oils which are the species claimed under e. See col.2, lines 10-55 for the two structures. See also cols. 3-4. The patent also teaches ingredient f at col.19, lines 1-40. The patent also teaches ingredients b-d. See col.17, lines 34 et seq and col.18 for the ingredients b. The cationic conditioning agent is taught at col.4, lines 35 et seq and cols. 5-6. The patent does not teach ingredient a) as an emulsion, but the patent teaches the both the ingredients claimed in a) which are cationic surfactant and silicone compounds. See silicone compounds at col.s 10-12 and col.13, lines 1-53 and see col.13, lines 55 et seq and col.14, cols 15-16, col.17, lines 1-32 for the cationic surfactant. See also the examples.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '655 and combine it with the *low melting oil which can be either fatty alcohol of claim 7 or either pentaerythritol ester oils or citrate ester oils of claim 8, and polyethylene glycol(claim 9)* of '515 expecting beneficial effect to the hair. The motivation to use the *low melting oil which can be either fatty alcohol of claim 7 or either pentaerythritol ester oils or citrate ester oils* stems from the teachings of '515 that the

compositions provide lasting moisturizing feel, smooth feel, manageability control to the hair and yet not leave the hair feeling greasy. The motivation to combine the ingredients flows logically from the art for having been used in the same hair care compositions. This is a *prima facie* case of obvious ness.

10. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-2439. The examiner can normally be reached on M-F, 9:30-6:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

*J. Venkat*  
JYOTHSNA A VENKAT  
Primary Examiner  
Art Unit 1615

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December 18, 2002